

Atty. Dkt. No. 025782-0111 (3648.Palm) (fka 035451-0135)

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim 1 has been amended. No new matter has been added.

After amending the claims as set forth above, claims 1-24 and 26-38 are now pending in this application.

### **Claims Rejections – 35 U.S.C. § 103**

The Examiner rejected claims 1-5, 8-17, 20-24, 26-29, 31-34, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Costales et al. (U.S. Patent No. 6,044,395) in view of Marks et al. (U.S. Published Patent Application No. 2001/0054059). Applicants respectfully traverse the rejection.

Costales teaches a method of sending personalized e-mail messages to recipients wherein each of the recipients receives messages which are personalized for them. To do this, Costales teaches that a common block of text is sent to the recipients and a personalized portion of the e-mail message is sent separately to the intended recipient and the first and second portions are then reassembled at the receiving computer.

With regard to independent claim 1, Applicants have claimed that the common chunk of information is not sent separately from the message. In fact, Applicants claim 1 recites “sending the selected and destination-specific information to the remote destination in a single message,” and “sending the selected and the second destination-specific information to the second remote destination in a single message,” among other limitations.

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Prior to Applicants' claimed invention, what was done in the art was that a personalized e-mail message was created and sent to a recipient and then a second personalized e-mail message was created and sent and then a third personalized e-mail message was created and sent and so on. What Applicants have claimed is a method of sending common information to multiple destination sources and including destination-specific information. This is done by selecting some of the information in the message as common information which will be sent to all of the recipients and adding destination-specific information to the selected common information. The assembled message is then sent. The assembly and sending is repeated for a second set of destination-specific information, using the common information.

Costales et al. teaches away from assembling personalized e-messages at the originating computer. In fact, Costales et al. states, with respect to the prior art, "For each personalized e-mail to be sent, a system following the SMTP protocol pre-creates and individually sends each personalized e-mail message. Pre-creating such personalized messages prior to transmission requires large local disk storage and wastes network bandwidth during transmission." (col. 2, lines 18-25). Accordingly, Costales et al. teaches away from sending selected and destination-specific information in a single message, which Applicants have claimed. The Examiner has stated that Marks et al. fills the deficiency of Costales et al. by teaching that batching of e-mail advertisements. Applicants respectfully submit that Marks et al. does not teach or disclose the claim limitations. Marks et al. does not teach combining generic information from a source file with destination-specific information and then forwarding that message to the specified destination and then using the same generic information that has been stored in memory and combining that information with different destination-specific information and sending that to a second-destination. Marks et al. teaches providing large batches of advertisements in a single message, where the batches of advertisements may be representative of different advertising subject matter.

Further, the arguments made above with regard to independent claim 1 are equally applicable to independent claims 12, 24, and 32.

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Thus, Applicants respectfully submit that the combination of Costales et al. and Marks et al. does not disclose, teach, or suggest all of the claim limitations of independent claim 1 and similarly of independent claims 12, 24, and 32, when used alone or applied in any proper combination. Accordingly, Applicants respectfully submit that independent claims 1, 12, 24, and 32 and their respective dependent claims are therefore allowable.

With regard to claims 6, 7, 18, 19, 30, 35 and 36 which the Examiner indicated as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Costales et al. in view of Marks et al. and Beck et al. (U.S. Patent No. 5,903,723). Applicants maintain that Beck et al. does not provide a suggestion for the deficiencies of Costales et al. in view of Marks et al.. Beck et al. only discloses the use of an attachment reference in an e-mail message. The teachings of Beck et al. thus have no logical connection to filling in the deficiencies of Costales et al. in view of Marks et al.. The fact that the advantages to combine are stated in Applicants' claims, is the essence of hindsight reasoning. Motivation to combine reference must be found in the references themselves or in the knowledge of those of ordinary skill in the art. Further, Applicants respectfully submit that in view of the amendments made to independent claims 1, 12, 24, and 32, claims 6, 7, 18, 19, 30, 35, and 36 which depend from the amended independent claims are also allowable and may not be rendered obvious over Costales et al. and Marks et al. in view of Beck et al..

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Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check

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being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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